

Beiersdorf 730-WCG  
8713-Hn/be**REMARKS****Summary of Amendments Made**

The limitation of claim 2 has been inserted into claim 1 (claim 2 has been cancelled). Claims 3 and 4 have been amended to address the examiner's 112, second paragraph rejection. Claim 10 has been amended to remove "range within a range"-type language; the second range has been reintroduced as new claim 19. Claims 12, 13 and 17 have been amended to correct typographical errors.

Claims 1-19 are now pending. It is believed that no new matter has been added.

**Objection to the Specification**

Please note that the Arrangement of the Specification section of MPEP 608.01(a) is only a guideline and not a requirement. As such there is no requirement that the Brief Description of the Drawings must appear before the Detailed Description.

**Claims Objections**

It is believed that the amendments made above address these objections.

**35 U.S.C. 112, second paragraph rejection**

It is believed that the amendments made above address this rejection.

**35 U.S.C. 103(a) rejection**

Claims 1-18 were rejected as being obvious over Ludwig (U.S. Patent 5,122,219) in view of Moriarity (U.S. Patent 6,273,701).

Claims 1-7 and 9-18 were rejected as being obvious over Bayer et al. (EP 622 127 A1) in view of Moriarity, *supra*.

In order to expedite prosecution of the application, the limitation of claim 2 has been inserted into claim 1 (applicants reserve the right to recover the broader subject matter in a divisional application). Although it was asserted that Ludwig or Bayer et al. in view of Moriarity suggested broad temperature control, neither reference teaches or suggests having at least two zones temperature-controlled differently in its cross section and/or along its longitudinal axis as is currently claimed by the applicants.

Moreover, the additional reasons in support of the rejection appear directed toward:

- (1) Rationales which are promulgated by the examiner to combine the references are not found or suggested by the respective references, i.e. MPEP 2143 states that "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)".

This has been further affirmed and illustrated in *Brown & Williamson Tobacco Corp. v.*

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*Philip Morris Inc.*, 56 USPQ2d 1459, (CAFC 2000) which stated:

"The first requirement is that a showing of a suggestion, teaching, or motivation to combine the prior art references is an *'essential evidentiary component of an obviousness holding.'* *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This evidence may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. See *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1826, 1630 (Fed. Cir. 1998). However, the suggestion more often comes from the teachings of the pertinent references. See *In re Rouffat*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusionary statements about the teaching of multiple references, standing alone, are not 'evidence.' See *Dambiczak*, 175 F.3d at 1000, 50 USPQ2d at 1617."

- (2) Optimization of parameters which are not recognized as results-effective by their respective specifications, see MPEP 2144.05 section II (Optimization of Ranges) states that "A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977)."

Therefore, for the reasons given above, it is believed that the examiner would be justified in withdrawing the rejections based on the above cited prior art.

#### Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,  
Norris, McLaughlin & Marcus, P.A.

By: Howard C. Lee  
Howard C. Lee  
Reg. No. 48,104

220 East 42<sup>nd</sup> Street  
30<sup>th</sup> Floor  
New York, New York 10017  
(212) 808-0700

#### CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 (6 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 14 July 2003

By: Valma I. Fernandez  
Valma I. Fernandez